ADDITIONAL FEE

Please charge any insufficiency of fees, or credit any excess, to Deposit Account No. 14-1263.

REMARKS

Claims 1-3 are pending and were amended to address the examiner's objections to use of the passive voice in claims 2 and 3 as well as to enhance the readability of the claims. It is believed that the scope of the claims has not changed nor has any new matter been added.

35 U.S.C. 102(b) rejection and "New Matter" rejection

Claims 1-3 were rejected over Schambil et al. (DE 4,010,393) under the presumption that the amendment to the weight % range of the oil phase in claim 1 constituted new matter. The applicants' previous response erroneously attributed support for the upper limit of the weight % range to example 4 of the specification when example 3 was intended. Example 3 utilized glyceryl isostearate (1.8%) and isodecyl isononanoate (10%) as the oil phase components. Given that each of the other examples cited by the applicants are below 11.8% by weight, it is presented that one of ordinary skill in the art "would consider (the claimed weight ranges) inherently supported by the discussion in the original disclosure." (see MPEP 706.03(o) and 2163.05 (Range Limitations)).

As such, Schambil et al. does not anticipate the applicants claims as the weight % range for their oil phase is greater than 11.8%. In addition, Schambil et al. does not disclose a microemulsion which is transparent or translucent as claimed by the applicants and does not disclose a step of heating to a temperature above the phase inversion temperature range and then subsequently cooling to room temperature (i.e. even if the components and ranges used in Schambil et al. were identical, they would not result in the same microemulsion).

35 U.S.C. 102(e) rejection

Claims 1-3 are rejected over Allard et al. as it is asserted by the examiner that Allard et al. (col. 5, lines 28-43) contemplates the use of as little as 5% oily phase and that to use such low concentrations in microemulsions would have been obvious.

However, Allard et al. is able to achieve their microemulsion not through regulation of the oil content but through the use of nanopigments (which is also part of their claimed invention). Allard et al. teaches the criticality of this component in col. 5, line 66 through col. 6, line 4 which reads:

> "Per an ***essential feature of this invention, nanopigments must be present in the final ultrafine***

O/W emulsion. Thus, in a first embodiment of the preparative process according to the invention, ***the phase inversion of the emulsion is conducted in the presence of the photoprotective nanopigments*** described above."

Thus, the teachings of Allard et al. represents a teaching away from the applicants' invention as the applicants do not require the presence of nanopigments (e.g. metal oxides - see claim 1 of Allard et al.) in order to form their claimed translucent/transparent microemulsions.

The examiner presented that one would be motivated to use less oil on the basis of cost (i.e. cost of oil vs. water). However, following that same motivation, one would not be motivated to use the teaching of Allard et al. for the same reason as Allard et al. requires the additional expenditure for the cost of the nanopigments which is a required component for their microemulsions.

Even if *in arguendo*, it is held that the term "comprising" is open to the inclusion of nanopigments in the applicants claimed microemulsion, it is noted that: (1) none of the applicants examples use a metal oxide nanopigment as in Allard et al. and (2) Allard et al. directs the artisan to incorporate the nanopigment at the very start of making the microemulsion whereas no such direction is given in the applicants claims.

Applicants believe that this application is in condition for allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that the foregoing Amendment under 37 CFR § 1.111 is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Hon. Commissioner of Patents, Washington, D.C. 20231, on the date indicated below:

Date: **7 August 2001** By Howard C. Lee

Howard C. Lee

Copy of claims showing amendments

1. Transparent or translucent microemulsions of the oil-in-water type

   - comprising ≤ 11.8**[5]**% by weight of an oil phase, composed essentially of constituents of low volatility, and an aqueous phase
   - containing:

     one or more polyethoxylated O/W emulsifiers and/or one or more polypropoxylated O/W emulsifiers and/or one or more polyethoxylated and polypropoxylated O/W emulsifiers,
   - and **[also containing]** ***optionally*** one or more W/O emulsifiers, **[if desired,]**
   - having an emulsifier content of less than 20% by weight, based on the total weight of the emulsion,
   - and obtainable by a process in which a mixture of the base components, comprising the aqueous phase, the oil phase, one or more of the O/W emulsifiers according to the invention, ***optionally*** one or more W/O emulsifiers, **[if desired,]** and ***optionally*** other auxiliary substances, additives and/or active substances, **[if desired,]** is brought to a temperature within or above the phase inversion temperature range and then cooled to room temperature.

2. **[P]** ***A p***rocess for the preparation of transparent or translucent O/W microemulsions which comprise:

(1) an aqueous phase **[comprising, if desired, conventional]** ***with optional*** substances soluble or dispersible in water,

(2) an oil phase **[which is composed essentially of]** ***comprising*** constituents of low volatility and **[which comprises, if desired, conventional]** ***optional*** substances soluble or dispersible in the oil phase,

(3) one or more polyethoxylated O/W emulsifiers and/or one or more polypropoxylated O/W emulsifiers and/or one or more polyethoxylated and polypropoxylated O/W emulsifiers, and

(4) **[if desired,]** ***optionally*** one or more W/O emulsifiers,

which process comprises

(a) the initial concentrations of the oil phase, the aqueous phase and, **[if desired,]** ***optionally*** one or more W/O emulsifiers are chosen and these constituents are added to one another ***to form a mixture***,

(b) the initial concentration of the O/W emulsifier or emulsifiers, which may also be equal to zero, is chosen and this O/W emulsifier or these O/W emulsifiers are added to the mixture obtained in (a),

(c) the mixture obtained in (b) having a starting temperature, and

(d) the mixture obtained in (b) by appropriate variation of at least one parameter selected from the group comprising the temperature and the concentration or concentrations of at least one of the chosen emulsifiers

and/or of the oil phase and/or of the aqueous phase, and the mixture formed passes through the phase inversion region between W/O emulsions and O/W emulsions and is brought into the region where the mixture exists as an O/W emulsion or O/W microemulsion.

3. **[P]** ***A p***rocess for the preparation of transparent or translucent O/W microemulsions according to Claim 1, which process comprises a mixture of the base components, comprising the aqueous phase, the oil phase, one or more of the O/W emulsifiers **[used according to the invention]**, ***optionally*** one or more W/O emulsifiers, **[if desired,]** and ***optionally*** other auxiliary substances, additives and/or active substances which form an O/W emulsion below the phase inversion temperature range, **[if desired,]** is brought to a temperature

- at which the components soluble in the oil phase **[are either dissolved]** ***dissolve*** or ***are*** at least in the molten state,
- which corresponds at least to the melting point of the highest-melting oil component not present in the dissolved state,
- and which is below the phase inversion temperature range of the system,

and the resulting O/W emulsion is then cooled to room temperature to form an O/W microemulsion.